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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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09/125,700

10/23/1998

THOMAS FUHRMANN

200-008181-U

8084

7590

02/10/2006

NOKIA, INC.  
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EXAMINER

HONG, HARRY S

ART UNIT

PAPER NUMBER

2642

DATE MAILED: 02/10/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/125,700

Applicant(s)

FUHRMANN ET AL.

Examiner

Harry Hong

Art Unit

2642

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 07 October 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-9, 11-13 and 15-17 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-9, 11-13 and 15-17 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

### **DETAILED ACTION**

1. Prosecution on the merits of this application is reopened. The previous office action mailed 9/7/05 is hereby vacated. The following is non-final office action.

#### ***Specification***

2. The specification is objected to under 35 U.S.C. 132(a) because it has been amended (amendment filed 10/9/02) to include new matter. 35 U.S.C. 132(a) states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is: new Fig. 6 and its description. Fig. 6 and its description were added to introduce a new "third embodiment".

Applicant is required to cancel the new matter in the reply to this Office Action.

#### ***Claim Rejections - 35 USC § 112***

3. Claims 1 – 9, 11-13 and 15-17 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claims contain subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

The specification contains 2 embodiments; the first embodiment represented by Figs. 1 – 4 and their description, and the second embodiment represented by Fig. 5 and its description. See for example, page 4 of the specification which refers to "a first

embodiment", "a second embodiment" and "two embodiments". The original specification has no reference to a third embodiment.

Figs. 1 - 4 and the description of the first embodiment are directed to the press-on/catch closure (element 11, Fig. 1) which makes cover 14 (Fig. 1) "releasably attached" to the bottom 2, and are not concerned with any specific components or any specific arrangements for the electronic circuitry inside the telephone. It is inherent that the telephone has some electronic circuitry, but again, the invention in the first embodiment is not drawn to any specific arrangement or components.

It is the second embodiment (Fig. 5) that is drawn to the specific arrangement of specific components inside the telephone.

That is, the first embodiment (Figs. 1-4) is drawn an external releasable press-on/catch closure while the second embodiment (Fig. 5) is drawn to the internal components of the telephone. In the second embodiment, the external covers of the telephone are attached via screws 43 (not press on/catch closure)<sup>1</sup>

Also, one must note that the top cover in the first embodiment (see Figs. 1 and 2) is different from the top cover in the second embodiment (see Fig. 5). The buttons, display, shape ... etc dot not match. Furthermore, it is also noted the covers and common elements between Fig. 1 and Fig. 5 have been given different reference numerals. Normally, if the same exact element is used in another figure, the same reference numeral is used in the different figures, and hence the use of different

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<sup>1</sup> The press on/catch closure is used to make it easy and convenient for users to release the cover (14, Fig. 1). The use of screws (43, Fig. 5) does not provide the same ease and convenience.

reference numerals has, at least, the appearance that applicant intended the parts in Fig. 1 and Fig. 5 to be different.

Claim 1 recites limitations about the external first and second housing (2 and 14, Fig. 1) being “**releasably attachable**” by the use of the “**press on/catch closure** [11, Fig. 1]” to modify the “external appearance” of the telephone (features from the 1<sup>st</sup> embodiment) and also recites limitations about the “**retaining means** [35, Fig. 5] ..... Including said **key sensor** [29a, Fig. 5] but excluding said **key unit** [24, Fig. 5] (features from the 2<sup>nd</sup> embodiment).

Independent claims 15, 16 and 17 recite the same or similar features.

Thus, the claims are directed to a combination of features from the first embodiment and the second embodiment that lacks support in the specification.

The specification simply provides a generic and broad statement (page 10, 2<sup>nd</sup> paragraph) which states that:

*“The present invention may include any novel feature or combination of features disclosed herein either explicitly or implicitly or any generalisation thereof .....”*

It is believed that the above statement, which may refer to an infinite number of possible combinations of features, does not provide enablement. Again, the “mixing and matching” of features from two separate embodiments is not supported by the original specification. While the original specification does not intermix the two embodiments, it appears that applicant attempted to do just that in the appeal brief filed 4/10/04. The

examiner's response to the "summary of the invention" (examiner's answer, 6/30/04, page 4) is hereby incorporated by reference. In it, the examiner, in part, clearly states that the key unit 8 in Fig. 1 of the first embodiment is fixed to the first housing 2,3 while the key unit 24 in Fig. 5 of the second embodiment is not fixed to housing 18.

***Claim Rejections - 35 USC § 103***

4. Claims 1-9, 11-12 and 15 – 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kobayashi et al (U.S. Patent 5,722,055) in view of Semenik et al (U.S. Patent 5,233,506).

This rejection has been provided in the Final office action (8/27/03) and in the Examiner's answer (6/30/04) and is hereby incorporated by reference.

5. Claim 13 is rejected under 35 U.S.C. 103(a) as being unpatentable over Kobayashi et al (U.S. Patent 5,722,055) in view of Semenik et al (U.S. Patent 5,233,506), as discussed above, and further in view of Takagi (U.S. Patent 5,235,636).

This rejection has been provided in the Final office action (8/27/03) and in the Examiner's answer (6/30/04) and is hereby incorporated by reference


6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Harry Hong whose telephone number is 571-272-7485. The examiner can normally be reached on Mon-Fri, 8:30 AM - 5:00 PM.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ahmad F. Matar can be reached on 571-272-7488. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Harry Hong  
Primary Examiner

  
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SUPERVISORY PATENT EXAMINER  
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